



UNITED STATES PATENT AND TRADEMARK OFFICE

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COMMISSIONER FOR PATENTS  
UNITED STATES PATENT AND TRADEMARK OFFICE  
WASHINGTON, D.C. 20231  
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AUG 12 2002

In re

:  
: DECISION ON  
: PETITION FOR REGRADE  
: UNDER 37 CFR 10.7(c)  
:

**MEMORANDUM AND ORDER**

(petitioner) petitions for regrading her answers to questions 5, 7, 33, 38, and 41 of the afternoon session of the Registration Examination held on October 17, 2001. The petition is denied to the extent petitioner seeks a passing grade on the Registration Examination.

**BACKGROUND**

An applicant for registration to practice before the United States Patent and Trademark Office (USPTO) in patent cases must achieve a passing grade of 70 in both the morning and afternoon sessions of the Registration Examination. Petitioner scored 66.

On February 1, 2002, petitioner requested regrading, arguing that the model answers were incorrect.

As indicated in the instructions for requesting regrading of the Examination, in order to expedite a petitioner's appeal rights, a single final agency decision will be made regarding each request for regrade. The decision will be reviewable under 35 U.S.C. § 32. The Director of the USPTO, pursuant to 35 U.S.C. § 2(b)(2)(D) and 37 CFR 10.2 and 10.7, has delegated the authority to decide requests for regrade to the Director of Patent Legal Administration.

### **OPINION**

Under 37 CFR 10.7(c), petitioner must establish any errors that occurred in the grading of the Examination. The directions state: "No points will be awarded for incorrect answers or unanswered questions." The burden is on petitioners to show that their chosen answers are the most correct answers. The directions to the morning and afternoon sessions state in part:

Do not assume any additional facts not presented in the questions. When answering each question, unless otherwise stated, assume that you are a registered patent practitioner. The most correct answer is the policy, practice, and procedure which must, shall, or should be followed in accordance with the U.S. patent statutes, the USPTO rules of practice and procedure, the Manual of Patent Examining Procedure (MPEP), and the Patent Cooperation Treaty (PCT) articles and rules, unless modified by a court decision, a notice in the *Official Gazette*, or a notice in the *Federal Register*. There is only one most correct answer for each question. Where choices (A) through (D) are correct and choice (E) is "All of the above," the last choice (E) will be the most correct answer and the only answer which will be accepted. Where two or more choices are correct, the most correct answer is the answer that refers to each and every one of the correct choices. Where a question includes a statement with one or more blanks or ends with a colon, select the answer from the choices given to complete the statement which would make the statement *true*. Unless otherwise explicitly stated, all references to patents or applications are to be understood as being U.S. patents or regular (non-provisional) utility applications

for utility inventions only, as opposed to plant or design applications for plant and design inventions. Where the terms “USPTO” or “Office” are used in this examination, they mean the United States Patent and Trademark Office.

Petitioner has presented various arguments attacking the validity of the model answers. All of petitioner’s arguments have been fully considered. Each question in the Examination is worth one point.

Petitioner has been granted one additional point on the Examination for her answer (B) to afternoon question 5. No credit has been awarded for afternoon question 7, 33, 38, or 41. Petitioner’s arguments for these questions are addressed individually below.

Afternoon question 7 reads as follows:

7. Izzy decides one day that the hydrogen fuel cell research in which he is engaged shows great potential and retains the services of a patent law firm. A patent application is promptly prepared and filed in the USPTO disclosing and claiming a hydrogen fuel cell wherein the electrodes employed to catalyze the hydrogen gas into positive ions and negative ions consist of a platinum catalyst. The original claims are fully supported by the application as filed. Two preliminary amendments are submitted after the original filing, but prior to initial examination. In the first preliminary amendment, the specification, but not the claims, is amended to recite that the electrodes may consist of a niobium catalyst. In the second preliminary amendment, the specification and the claims are amended to recite that the electrodes may consist of an iridium catalyst. In the first Office action, the examiner determined that both amendments involve new matter and required their cancellation. In addition, the examiner rejected all the claims under 35 U.S.C. § 112, first paragraph on the ground that they recited elements without support in the original disclosure. Ultimately, the examiner issued a Final Rejection on the same basis. Based upon proper USPTO practice and procedure, which of the following is correct?

- (A) Review of the determination that both the first preliminary amendment and the second preliminary amendment contain new matter is by appeal.
- (B) Review of the determination that both the first preliminary amendment and the second preliminary amendment contain new matter is by petition.

- (C) Review of the determination that the first preliminary amendment contains new matter is by appeal, and review of the determination that the second preliminary amendment contains new matter is by petition.
- (D) Review of the determination that the first preliminary amendment contains new matter is by petition, and review of the determination that the second preliminary amendment contains new matter is by appeal.
- (E) (A), (B), (C), and (D).

The model answer is selection (D).

7. ANSWER: (D) is the correct answer. MPEP § 608.04(c) (“Where the new matter is confined to amendments to the specification, review of the examiner’s requirement for cancellation is by way of petition. But where the alleged new matter is introduced into or affects the claims, thus necessitating their rejection on this ground, the question becomes an appealable one.”); see, also, MPEP § 706.03(o) (“In amended cases, subject matter not disclosed in the original application is sometimes added and a claim directed thereto. Such a claim is rejected on the ground that it recites elements without support in the original disclosure under 35 U.S.C. § 112, first paragraph.”). (A), (B), and (C) are incorrect. (E) is incorrect inasmuch as (A), (B) and (C) are incorrect.

Petitioner’s arguments have been fully considered but are not persuasive.

Petitioner has argued that answers (A) and (D) are equally correct because it would be proper to assume that the first preliminary amendment amends the specification in such a way that it “affects” the claims. The fact pattern clearly indicates that “the specification, but not the claims, is amended” [emphasis added]. The DIRECTIONS to the afternoon session indicated “Do not assume any additional facts not presented in the questions.” It is improper to assume that the amendment “affects the claims” when the fact pattern specifically indicates that the claims were not amended, and when the fact pattern specifically indicates that the original claims were fully supported by the application as filed. Answer (D) is the most correct answer based on the facts given.

No error in grading has been shown. Petitioner's request for credit on this question is denied.

Afternoon question 33 reads as follows:

The following facts pertain to questions 33 and 34.

Applicant Sonny filed a patent application having an effective U.S. filing date of February 15, 2000. The application fully discloses and claims the following:

Claim 1. An apparatus for converting solar energy into electrical energy comprising:

- (i) a metallic parabolic reflector;
- (ii) a steam engine having a boiler located at the focal point of the metallic parabolic reflector; and
- (iii) an electrical generator coupled to the steam engine.

In a non-final Office action dated March 15, 2001, the examiner rejects claim 1 under 35 U.S.C. § 102(d) as anticipated by a patent granted in a foreign country to Applicant Sonny ("Foreign patent"). The Foreign patent was filed February 1, 1999, and was patented and published on January 17, 2000. The examiner's rejection points out that the invention disclosed in the Foreign patent is a glass lens with a steam engine having a boiler at the focal point of the glass lens, and an electrical generator coupled to the steam engine. The rejection states that the examiner takes official notice that it was well known by those of ordinary skill in the art of solar energy devices, prior to Applicant Sonny's invention, to use either a lens or a parabolic reflector to focus solar rays.

33. Sonny informs you that you should not narrow the scope of the claims unless absolutely necessary to overcome the rejection. Which of the following, in reply to the Office action dated March 15, 2001, is best?

- (A) Traverse the rejection arguing that the examiner's use of the Foreign patent is improper because an applicant cannot be barred by a foreign patent issued to the same applicant.
- (B) Amend claim 1 to further include a feature that is disclosed only in the U.S. application, and point out that the newly added feature distinguishes Sonny's invention over the invention in the Foreign patent.
- (C) Traverse the rejection arguing that the examiner does not create a *prima facie* case of obviousness because the examiner does not show why one of ordinary skill in the art of solar energy devices would be motivated to modify the Foreign patent.

- (D) Traverse the rejection arguing that the examiner's rejection under 35 U.S.C. § 102(d) was improper because claim 1 is not anticipated by the Foreign patent.
- (E) Traverse the rejection arguing that it was not well known to use either a lens or a parabolic reflector to focus solar rays, and submit an affidavit under 37 CFR 1.132.

The model answer is selection (D).

33. ANSWER: (D) is the correct answer. MPEP § 706.02 points out the distinction between rejections based on 35 U.S.C. §§ 102 and 103. For anticipation under 35 U.S.C. § 102 the reference must teach every aspect of the claimed invention either explicitly or impliedly. (A), (B), (C), and (E) are each incorrect because each response does not address the lack of anticipation by the Foreign patent. (A) is further incorrect because an applicant can be barred under 35 U.S.C. § 102(d). (B) is further incorrect because the facts do not present the necessity of such an amendment. (C) is further incorrect because a prima facie case of obviousness is not necessary in a rejection under 35 U.S.C. § 102.

Petitioner chose answer (E) to Afternoon question 33. Petitioner has argued that “the examiner rejected the claim under 35 U.S.C. § 102(d) as anticipated by a Foreign Patent in view of official notice,” and that this rejection “is a rejection under § 103(a).” The argument is not persuasive. Afternoon question 33 states that “the examiner rejects claim 1 under 35 U.S.C. § 35 U.S.C. § 102(d) as anticipated by [the Foreign patent].” It does not indicate that the rejection was made under § 103(a). A reply to a rejection under 35 U.S.C. § 103(a) is not required under 37 CFR 1.111(b), because the examiner did not make a rejection under 35 U.S.C. § 103(a). A reply to the rejection the examiner did make under 35 U.S.C. § 102(d) is required. Answer (E) is not the best answer because it does not address the rejection under 35 U.S.C. § 102(d) set forth by the examiner. Answer (D) is the best answer because it does address the grounds of rejection set forth by the examiner in the Office action.

No error in grading has been shown. Petitioner's request for credit on this question is denied.

Afternoon question 38 reads as follows:

38. Your clients, Able and Baker, filed a patent application. In accordance with proper USPTO practice and procedure, in which of the following instances, absent additional facts, is the reference or event either prior art or an act that may not be properly applied to reject claims in your client's application?

- (A) The patent application was filed on Tuesday, June 26, 2001 in the USPTO. The reference is an article in a trade magazine published on November 10, 2000. Able, Baker and McGeiver are the authors of the article. The article fully discloses the claimed invention and how to make and use it.
- (B) The patent application was filed on Monday, June 25, 2001 in the USPTO. Able and Baker placed the invention on sale in the United States on Monday, June 26, 2000. The public came into possession and understands the invention the day it is placed on sale. Your clients have disclosed this information when they filed the application.
- (C) The patent application was filed on Monday, June 25, 2001, in the USPTO. McGeiver, a friend of Baker, publicly used the invention in Hawaii on April 15, 2000. The public use was not experimental and was without Baker's knowledge or consent. The public came into possession of the invention the day it was used by McGeiver.
- (D) The patent application was filed on Monday, June 25, 2001, in the USPTO. The invention became known to the public in the United States in April 2000 as a result of disclosure on the Internet by Wilson, a party unknown to Able and Baker. The invention was not placed on sale or in public use prior to the filing date of the application.
- (E) More than one year prior to the filing in the USPTO of a patent application on Monday, June 25, 2001, in the USPTO, the invention, a machine, was used secretly by John, another inventor, to make a product. The details of the invention are ascertainable by inspection or analysis of the product made by John that was sold and publicly displayed.

The model answer is selection (B).

38. ANSWER: The most correct answer is (B). 35 U.S.C. § 102(b). The on sale activity by the inventors was not a statutory bar since the one year anniversary ends on Tuesday,

June 26, 2001. (A) is not the correct answer. 35 U.S.C. § 102(a). The reference, published before the filing date of the client's application, is prior art under 35 U.S.C. 102(a). The inventive entity is Able and Baker. The authorship is "by others," Able, Baker, and McGeiver. The reference is prior art "by others." See MPEP § 2132 ('Others' Means Any Combination Of Authors Or Inventors Different Than The Inventive Entity), and MPEP § 2132.01. See also *In re Katz*, 215 USPQ 14 (CCPA 1982). (C) is not correct. 35 U.S.C. § 102(b). The invention was placed in public use more than one year before the filing date of the patent application. See MPEP § 2133 (The 1 – Year Time Bar Is Measured From The U.S. Filing Date); MPEP § 2133.03(a); and *Egbert v. Lippmann*, 104 U.S. 333, 336 (1881). (D) is not correct. Although public knowledge may not be a public use or sale bar under 35 U.S.C. 102(b), it can provide grounds for rejection under 35 U.S.C. 102(a). MPEP §§ 2132 and 2133.03(a)(C) (Use by Independent Third Parties). In this instance, the public knowledge is more than one year before the application filing date. (E) is not correct. 35 U.S.C. § 102(b). A "secret" use by another inventor of a machine to make a product is "public" if the details of the machine are ascertainable by inspection or analysis of the product that is sold or publicly displayed. *Gillman v. Stern*, 46 USPQ 430 (2d Cir. 1940); *Dunlop Holdings v. Ram Golf Corp.*, 188 USPQ 481, 483 - 484 (7th Cir. 1975); *W.L. Gore & Assocs. v. Garlock, Inc.*, 220 USPQ 303, 310 (Fed. Cir. 1983).

Petitioner's arguments have been fully considered but are not persuasive.

Petitioner has argued that (B) is not the most correct answer because the sale is not prior art. In answer (B), there is nothing to indicate there was any public use or on-sale activity in the United States prior to Monday June 26, 2000. Accordingly, the act of placing the invention on sale as discussed in answer (B) may not be properly applied to reject claims in the application because there is no reason to believe such activity took place more than one year prior to the date of the application for patent in the United States. Petitioner has argued that answer (E) is the most correct answer because the sale and public display of the product would not be available to reject the claims if the sale and public display of the product occurred after the filing of the client's application. Petitioner's arguments are not persuasive. Answer (E) specifically indicates that the

machine was used more than one year prior to filing the application. The product that was made more than one year prior to the filing of the application placed the public in possession of John's invention. Absent additional facts (e.g., that the product itself was kept secret until after Able & Baker's filing date), the public had possession of the invention before Able & Baker's filing date. Answer (E) is not the most correct answer.

No error in grading has been shown. Petitioner's request for credit on this question is denied.

Afternoon question 41 reads as follows:

41. Mark Twine obtains a patent directed to a machine for manufacturing string. The patent contains a single claim (Claim 1) which recites six claim elements. The entire interest in Twine's patent is assigned to the S. Clemens String Co., and Twine is available and willing to cooperate with S. Clemens String Co. to file a reissue application. A subsequent reissue application includes Claim 2, which is similar to original Claim 1. However, one of the elements recited in Claim 2 is broader than its counterpart element in the original claim. The remaining five elements are narrower than their respective counterpart elements in the original patent claim. Which of the following scenarios accords with USPTO proper practice and procedure?

- (A) The S. Clemens String Co. files the reissue application more than 2 years after the issue date of the original patent application.
- (B) The S. Clemens String Co. files the reissue application less than 2 years after the issue date of the original patent but more than 2 years after original application filing date.
- (C) Mark Twine files the reissue application less than 2 years after the issue date of the original patent but more than 2 years after original application filing date.
- (D) Mark Twine files the reissue application more than 2 years after the issue date of the original patent.
- (E) Mark Twine and the S. Clemens String Co. jointly file the reissue application more than 2 years after the issue date of the original patent.

The model answer is selection (C).

41. ANSWER: (C) is the correct answer. Answers (A), (D) and (E) are incorrect because a broadening reissue application must be filed within two years of issuance of the original patent. 35 U.S.C. § 251; MPEP § 1412.03. Answer (B) is incorrect because the assignee may not file a broadening reissue application. MPEP § 706.03(x).

Petitioner's arguments have been fully considered but are not persuasive.

Petitioner has argued that both answers (B) and (C) are flawed, but that in both scenarios, the applicant has the opportunity to correct the defective reissue application. Answer (B) is an incorrect answer because answer (B) indicates that the assignee files the reissue application. The statute, 35 U.S.C. 251, provides that "application for reissue may be made and sworn to by the assignee of the entire interest if the application does not seek to enlarge the scope of the claims of the original patent" [emphasis added]. Here the application for reissue seeks to enlarge the scope of the claims. Accordingly, the application must be made by the applicant rather than by the assignee.

No error in grading has been shown. Petitioner's request for credit on this question is denied.

**ORDER**

For the reasons given above, one additional point has been added to petitioner's score on the Examination. Therefore, petitioner's score is 67. This score is insufficient to pass the Examination.

Upon consideration of the request for regrade to the Director of the USPTO, it is ORDERED that the request for a passing grade on the Examination is denied.

This is a final agency action.

A handwritten signature in black ink, appearing to read 'Robert J. Spar', is positioned above the printed name and title.

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Robert J. Spar  
Director, Office of Patent Legal Administration  
Office of the Deputy Commissioner  
for Patent Examination Policy